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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,192	06/20/2002	Kattesh V. Katti	0994.00133	6247

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EXAMINER

KRASS, FREDERICK F

ART UNIT PAPER NUMBER

1614

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/019,192

Applicant(s)

KATTI ET AL.

Examiner

Frederick F. Krass

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **Previous Rejections**

Unless specifically maintained infra, all previous rejections are withdrawn.

### **Written Description Rejection**

Claim 4 was rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

This rejection is maintained.

Applicant states:

A chemotherapeutic agent is defined in Dorland's illustrated Medical Dictionary, 25<sup>th</sup> Edition as 'pertaining to chemotherapy', wherein chemotherapy is defined as the 'the treatment of disease by chemical agents; first applied to use of chemicals that affect the causative organism unfavorably, but do not harm the patient.' In other words, it pertains to agents that are capable of attacking disease, but preferably do not harm the individual patient. This therefore, can be distinguished from any currently available therapeutic... It is respectfully submitted that the disclosure of a chemotherapeutic agent is designed to characterize a type of chemotherapeutic agent, such that it is an agent that aids in the recovery from disease as opposed to any agent out there that does not cause harm. (Remarks, p. 3, ¶ 4; emphasis original).

This argument misses the point. The examiner is not rejecting the term "therapeutic agent" as being indefinite. He is rejecting it as being inadequately described. The above merely argues what a therapeutic agent is not. That still does not describe which agents are to be used in the instant invention. And, Applicant's arguments notwithstanding, the mere fact that therapeutics are generally known for use with gold treatments does mean that the skilled artisan could readily determine which chemotherapeutics or other therapeutics could be used therewith. Applicant provides no support for this assertion, which is contrary to state of the art: chemotherapy is in fact a highly unpredictable art (recall the previous enablement rejection). Indeed, Applicant tacitly recognizes this fact in the arguments presented at the first full paragraph of page 7 of the response.

### **Indefiniteness Rejection**

Claims 5-7 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained.

This rejection has been rendered moot with regard to claims 6 and 7. It is maintained with regard to claim 5, however, insofar as it does not appear that applicant amended claim 5 to recite "step" (singular).

### **Anticipation Rejection**

1) Claims 1-4 were rejected under 35 USC 102(b) as being anticipated by Koyima et al ("Synthesis of water-soluble tri(hydroxymethyl)phosphine)gold(I) complexes containing a nucleoside ligand", *Inorganica Chimica Acta*, vol. 217, pp. 201-202 (1994)).

This rejection is maintained.

Applicant argues that "the therapeutics included in the complex of the present invention are intended to be limited to compounds that treat disease and such limitations are disclosed throughout the specification and specifically at page 12, lines 26-30." (Remarks, p. 5, last ¶.) This argument is not understood. Applicant's arguments notwithstanding, the specification does not limit the definition of the term "therapeutic agent" in any way – indeed, it never defines it at all. Moreover, the prior art teaches that its products have potential use as chemotherapeutics (last line of the article). And finally, even if the prior art mentioned no therapeutic application, it still discloses gold-phosphine complexes which anticipate the instant claims, since the latter merely characterize same in terms of future intended use. The complexes themselves are the same, whatever use they are ultimately put to.

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2) Claims 1-4 were rejected under 35 USC 102(b) as being anticipated by Chemical Abstracts 127:144328.

This rejection is maintained.

Applicant again argues (apparently) that the instant claims are distinguished from those of the prior art because the latter are not used for the same therapeutic purposes as Applicant's. Again, the instant "intended use" preamble is not seen to distinguish over the prior art. Moreover, and contrary to Applicant's arguments, the "therapeutic" function of the agents recited by instant claim 4 is never specified; they do not necessarily have to be chemotherapeutic agents.

3) Claims 1-4 were rejected under 35 USC 102(e) as being anticipated by Okuhama et al (USP 6,183,545).

This rejection is maintained.

Again, the prior art complexes, which are otherwise identical to Applicant's, are not distinguished therefrom by the instant recitations of future intended use, nor recitations of some vague "therapeutic" function.

#### **Allowable Subject Matter**

Claims 5-7 are allowable as presently advised.

The prior art does not fairly teach, suggest or disclose using the instantly claimed hydroxyalkylphosphine-gold complexes to treat the particular types of cancer specified by the instant claims.

#### **Action is Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick F. Krass whose telephone number is 571-272-0580. The examiner's schedule is as follows:

Monday: 10:30AM- 7PM;  
Tuesday: 10:30AM - 7PM;  
Wednesday: off;  
Thursday: 10:30AM- 7PM; and  
Friday: 10:30AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached at 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

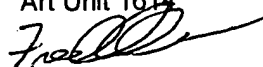
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Frederick Krass  
Primary Examiner  
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A handwritten signature in black ink, appearing to read 'Frederick Krass', written over the printed name.